Brief in Support of Petition.

I.

THE OPINIONS OF THE COURTS BELOW.

The opinion of the District Court is set forth at R. II, 557. It has not been reported. The findings of fact and conclusions of law of the District Court are set forth at R. II, 566-578.

The opinion of the Circuit Court of Appeals (R. II, 890) is reported in 114 F. (2d) 166.

II.

JURISDICTION.

(a) The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925 (28 U. S. C. § 347 (a)).

(b) The judgment or decree of the Court below, review of which is sought, is dated June 24, 1940 (R. II, 897). The order denying petition for rehearing in the Court below was filed September 24, 1940 (R. II, 902).

(c) Cases believed to sustain the jurisdiction of this Court to grant the writ of certiorari in the instant case are:

Rice & Adams v. Lathrop, 278 U. S. 500, 512;
Douglas v. Cunningham, 294 U. S. 207, 209;
Prudence Co. v. Fidelity Co., 297 U. S. 198, 205;
Duparquet Co. v. Evans, 297 U. S. 216, 217;
Appliance Co. v. Equipment Co., 297 U. S. 387, 392.

III.

STATEMENT OF THE CASE.

The nature of the case is stated in the petition and in the interest of brevity will not here be repeated. Further reference to the decision of the Circuit Court of Appeals, which may be necessary to show the position taken by that Court with respect to the several questions here presented, will be made in the ensuing argument.

IV.

SPECIFICATION OF ERRORS.

The errors which petitioner will urge, if the writ of certiorari is granted, are that the Circuit Court of Appeals for the Seventh Circuit erred:

(1) In ignoring the findings of fact of the District Court with respect to the Princette publication and the Kops Patent No. 1,833,325, in violation of the mandatory provision of Rule 52 (a) of the Federal Rules of Civil Procedure, that "Findings of fact shall not be set aside unless clearly erroneous."

(2) In disregarding and setting aside the findings of fact of the District Court without adjudging that such findings are "clearly erroneous."

(3) In substituting for the findings of fact made by the District Court, findings of its own which are nowhere supported by the record or evidence in the cause.

(4) In departing from the disclosures of the Princette publication and the Kops patent, and in reading into those references certain modifications thereof, possible only in the light of the teachings of the patents in suit, and in thereupon using such modified and reconstructed references to

invalidate the patents in suit on the ground of want of invention.

(5) In not holding Claims 3 to 8 inclusive of Patent No. 1,859,198 and Claim 1 of Patent No. 1,899,890 valid and infringed.

(6) In reversing the decree of the District Court.

SUMMARY OF ARGUMENT.

The points of the argument will be taken up in the order of their statement under the Reasons Relied On for Allowance of the Writ (Petition, p. 11). For the sake of brevity, they are not repeated at this point.

ARGUMENT.

Point 1. Rule 52(a) of the Federal Rules of Civil Procedure, Which Have, by Statute, the Force of Law, Provides That "Findings of Fact Shall Not Be Set Aside Unless Clearly Erroneous". Yet the Circuit Court of Appeals in This Case Reversed the Decree of the District Court Made Mandatory by the Findings of Fact of That Court, Without Adjudging Those Findings "Clearly Erroneous"; and Thereby the Court Below Has Decided an Important Question of Federal Law Which Has Not Been, but Should Be, Settled by This Court.

Without so much as indicating in its opinion wherein it deemed the evidence to be insufficient to support, or even in conflict with, the findings of fact made by the District Court with respect either to the patent in suit, the Princette publication or the Kops Patent No. 1,833,325, the Court below nevertheless disregarded and set aside those findings. Indeed, the Court below did not even refer to the *findings* of the District Court. Instead it substituted therefor independent findings of its own, which are not only unsupported by any finding of the District Court but which are in irreconcilable conflict with the uncontradicted evidence on which the findings of the District Court were based.

Thus, for example, the Court below, holding that the Princette garment "we think clearly anticipates both of the Cunningham patents" (R. II, 895), said:

> "It has the end sections which are sewed down on the sides of the corset to the waist line, and converge in the back *and terminate in elastics.* Moreover, *there is one elastic on each side; they diagonally cross;* and each is buttoned to the back of the garment, as in Cunningham."

But, from even a casual inspection of the Princette publication (which is the *only* evidence in the record with respect to the Princette garment), it is manifest that the Princette publication does not disclose or even remotely suggest the *structure* or *function* of the garments of the Cunningham patents here in suit. The sole purpose of the Princette garment was to provide a low back combination to serve as the correct foundation for what the publication itself called the "Princess Silhouette", and the only figure control which it purported to accomplish was provided by special seaming and boning. Thus, the descriptive matter accompanying the illustration of the Princette garment expressly states (R. II, 535):

> "The lines of the brassiere are so cut that an *extremely low decolletage* is possible without sacrifice of the necessary restraining qualities. *Clever seaming and boning control the figure admirably.*"

Moreover, there is, in the Princette publication, nothing whatever to show that the side sections of the brassiere have attached to their ends *any elastic whatever* or that there is *one elastic on each side.* On the contrary, the illustration of the Princette garment makes manifest that the tabs attached to the end sections are merely tabs for providing a buttonhole to secure the end sections in position at the back, while the garment is being worn, *and that the tabs do not cross, diagonally or otherwise.*

Based upon the clear and unequivocal disclosures of the Kops Patent No. 1,833,325 (R. II, 814-819), and the unchallenged and uncontroverted testimony of petitioner's expert, Mr. Marine (R. I, 109, 116-119), the District Court (R. II, 576) made the following findings of fact with respect to that patent:

"(79) Though some of the garments of the prior art, for example, that of Kops Patent No. 1,833,325, have vertical elastic panels, none discloses auxiliary forces supplied by the elastic straps, of the patents in suit, attached to end sections of a brassiere sewed to the front and down the sides of the garment to hold the front portion of the brassiere snugly against the body of the wearer, above and below the bust, without exerting pressure on the bust, while at the same time flattening the diaphragm and supporting the abdomen.

"(80) The element 44 in Figure 2 of Kops Patent 1,833,325 is but an elastic fastening means of the elements of the non-elastic straps 34 and 41, and was not designed or intended as an auxiliary force to mold the bust, flatten the diaphragm or support the abdomen.

"(81) In Kops Patent No. 1,833,325 neither the elastic 44 nor the non-elastic straps 34 and 41 are fixedly anchored to the corset as are the elastic straps of the Cunningham patents in suit, and so cannot produce, apply and distribute tensions and forces as do the structures of the patents in suit.

"(82) The non-elastic straps 34 and 41 of Kops Patent No. 1,833,325 are so attached to the corset that even were the force of elastic tape 44 very greatly increased, that force would be applied circumferentially instead of radially, as in the structures of the claims here in suit."

Yet the Court below, in clear defiance of these findings of the District Court, which were made mandatory by the evidence, and without in any way disturbing such findings or attempting to show that they were "clearly erroneous", made its own independent findings with respect to the Kops Patent No. 1,833,325.

Thus, to point out but a few of the many arbitrary and unwarranted findings by the Court below with respect to

Nov. 24, 1931

W. KOPS

1,833,325

APPAREL GARMENT

Filed April 15, 1930

2 Sheets-Sheet 1

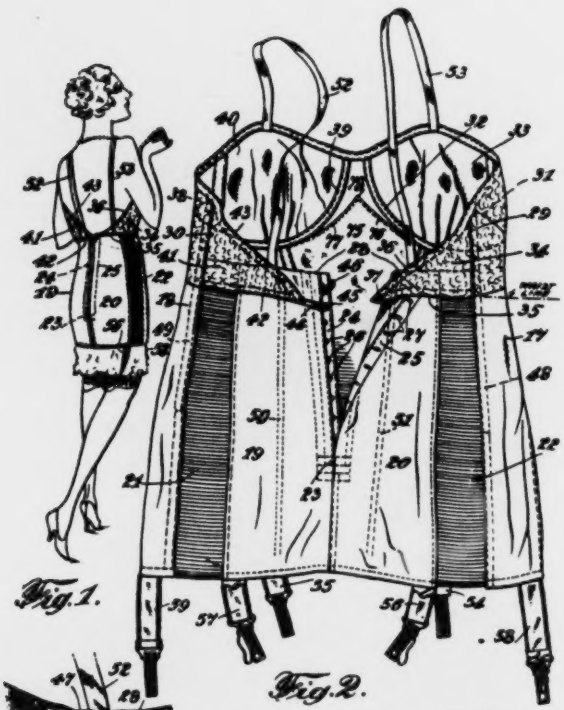

Fig. 1.

Fig. 2.

Fig. 5.

INVENTOR
Waldemar Kops
BY
H. G. Strauss
ATTORNEY

the Kops Patent, that Court, in its opinion (R. II, 892-3) said:

> "It is obvious that the Kops *construction* differs from Cunningham *only* in the fact that the former makes his triangle of cloth, which is the flap itself, to which he attaches one strip of elastic which engages a button on the free end of the other flap, whereas Cunningham constructs her triangle with the elastics, and her tabs which are attached to the respective points of the triangles engage buttons which in turn are attached to the corset. These buttons prevent the flap from working upward, while in Kops the same result is obtained by threading the elastic through a loop which is attached to the corset."

But in addition to that which the Court below referred to as the *only* difference between Kops [1] and Cunningham, there are at least seven other fundamental differences in construction, viz.:

(1) The "end sections" of Cunningham are sewed to the *front* portion of Cunningham's garments (R. II, 593, lines 71-78; R. II, 601, lines 28-32), whereas the "straps" of Kops (R. II, 818, lines 22-24, 45-48) are attached to the *rear* edge of the upwardly extending *side members* of his garment (R. II, 818, lines 11-13).

(2) The "side members" of Kops (to the lower rear edge of which he attaches his straps) extend above the upper edge of the back of the girdle (R. II, 818, lines 11-16) whereas Cunningham's are confined within the dimensions of the girdle (R. II, 592; Fig. 2; R. II, 600, Fig. 4).

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[1] For convenient reference, Sheet 1 of the drawings of Kops Patent No. 1,833,325 is set out upon the opposite page.

(3) Kops connects the adjacent ends of his "straps" with a tape, elastic or non-elastic, whereas the end sections of Cunningham are not connected.

(4) The "straps" of Kops are not crossed. The "end sections" of Cunningham are "crossed at the back." (R. II, 593, line 18).

(5) Along the rear edges of his side members, which extend above the top edge of the back member of his garment, Kops provides "stays" (i. e. strips of steel) (R. II, 818, lines 86-89).

Cunningham has no side members extending above the upper edge of the back member of her garments, and also has no such upwardly extending steel stays.

(6) In Kops, the lower edge of his "straps" extends "circumferentially of the garment" (R. II, 818, lines 48-51), and the "straps" are connected by a "horizontally extending tape" (R. II, 819, lines 53, 54); whereas, in Cunningham, her "end sections" are sewed to the *front* portion of the brassiere and down the side of the *front* of the corset to a point *below* the diaphragm of the wearer (R. II, 593, lines 71-75); and her *elastic* straps are so divergently arranged and so anchored as to give "an uplift form to the figure" (R. II, 594, lines 17-21), to "hold the diaphragm of the wearer flat" (R. II, 594, lines 8-9), to "confine and mold the abdomen" (R. II, 593, lines 6-7), and to hold the brassiere "above the busts snugly against the body of the wearer without exerting uncomfortable pressure *on the busts*" (R. II, 594, lines 9-12).

(7) The elastic straps of Cunningham are anchored at the back of her garment (R. II, 593, lines 80-83). The tape 44 connecting the straps of Kops is not attached to

the back of his garment save by a loop through which it is at all times free to move, and the sole purpose of which is to prevent the central portions of the straps 34 and 41 from working upwardly (R. II, 818, lines 59-64).

These additional differences in structure between the garment of Kops and the garments of Cunningham are not insignificant or immaterial. They have a most material effect upon the function and results of the two structures. As respondent uses the Cunningham structure in the precise form described and shown in the patents in suit, that precise structure must inevitably be necessary. *Diamond Rubber Co. v. Consol. Tire Co.*, 220 U. S. 428, 440-441.

These differences establish, and all the evidence shows, that Kops' garment was not designed by its maker, nor adapted, nor actually used, for the performance of the functions which the Cunningham garments were designed, adapted and constructed to perform. *Topliff v. Topliff and another*, 145 U. S. 156, 161.

Again, the Court below at R. II, 893, said:

> "The District Court was of the opinion that there was a distinction between Kops and Cunningham, in that Kops had no purpose in his invention to apply any appreciable force in uplifting the abdomen or restraining the diaphragm, or even the portion of the body above the breasts. However, *Cunningham does not claim any such purpose*, for in the specification of both of her patents she states that her object is to provide a garment adapted to correctly confine and mold the busts and the abdomen with complete comfort to the wearer and to fit closely above and below the busts without exerting appreciable pressure thereon."

This finding by the Court below not only disregards and ignores the findings of fact made by the District Court

Nos. 30-42, (R. II, 570, 573), but is in direct conflict with the specifications of the two Cunningham patents (R. II, 593, lines 23-50; R. II, 594, lines 17-21; R. II, 601, lines 38-55; R. II, 602, lines 62-64).

Again, the Court below at R. II, 893-4 said:

> "The District Court was further of the opinion that Cunningham distributed tension and pressure to the body of the wearer radially where most desired, and that Kops cannot produce, supply and distribute this tension and force as does Cunningham. *With this conclusion we are unable to agree* for, as we have pointed out, when force is applied to the free end of the triangle there is a reaction at all points between the laterals, no matter how far extended, unless and until they reach a solid and stationary base. This must be true, or the law of Newton in this respect must be held for naught."

But, *nowhere in the whole of Kops' patent is tension, pull or force mentioned.*

In the absence of any disclosure by Kops of the presence or utilization of a force, no law, whether Newton's or another's, with respect to force, has here any pertinence. Kops cannot, without complete reconstruction, produce, supply and distribute tension as does Cunningham. To radiate tension to the desired parts of the front of the figure of the wearer, the steel "stays" of Kops must be removed. The "straps" of Kops must be made the "end sections" of Cunningham and sewed not to the *rear* edges of the "side members" but to the *front* portion of the brassiere and down the edges of the *front* part of the corset. Before Kops can mold the abdomen, he must cease making the lower edge of his straps, connected at their peak with "a horizontally extending tape", extend circumferentially of his garment, and employ, as does petitioner, the diverging forces with

their anchorages as first disclosed and claimed in the patents in suit.

Moreover, since Kops' tape joins horizontally the ends of his "straps" the lower edge of which extends circumferentially of the garment, the only force that Kops could apply would be a straight-line circumferential force. If such straight-line circumferential force had any lateral components (which in such force Newton does not recognize (R. I, 131)), it is obvious that the force would be greater on the busts (where not wanted) than above them where it is desired and supplied by Cunningham to hold the garment snugly against the chest.

And again, at R. II, 894, the Court below said:

> "The elements involved are all old and produce no new result."

But nowhere in the prior art is there any disclosure of end sections having the form and function of the patents in suit.

Nowhere in the prior art is there such an arrangement of flaps, corresponding to the end sections of Cunningham, one part of which is attached to the front of the brassiere and down the edge of the front of the corset, and which also have attached to their opposite free ends elastic straps or forces, anchored, crossed and distributed as in Cunningham.

Nowhere in the entire prior art has anyone ever produced the results which are produced by the garments of Cunningham, which results were demonstrated on living models to the trial court during the testimony of Mrs. Slamin (R. I, 35, et seq.).

It is thus manifest that the Court below has, by its action in the instant case, disregarded and nullified the mandatory provision of Rule 52 (a) of the Federal Rules of Civil Procedure that

> "Findings of fact shall not be set aside unless clearly erroneous, * * *."

In so doing, the Court below has decided an important question of federal law which has not been, but should be, settled by this Court.

The Federal Rules of Civil Procedure were promulgated by this Court pursuant to the Act of June 19, 1934, Chapter 651 (48 Stat. 1064), Section 1 of which provides, inter alia:

> "That the Supreme Court of the United States shall have the power to prescribe, by general rules, for the district courts of the United States and for the courts of the District of Columbia, the forms of process, writs, pleadings, and motions, and the practice and procedure in civil actions at law. Said rules * * * shall take effect six months after their promulgation, and thereafter all laws in conflict therewith shall be of no further force or effect."

The Rules thus have, by statute, the force and effect of law.

Rule 52 (a) provides, in part, as follows:

> "*Effect.* In all actions tried upon the facts without a jury, the court shall find the facts specially and state separately its conclusions of law thereon and direct the entry of the appropriate judgment; * * * *Findings of fact shall not be set aside unless clearly erroneous,* and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."

In no case, so far as counsel are advised, has the precise meaning and effect of the foregoing italicized portion of the Rule been determined and declared by this Court unless it is the intention of this Court that such provision of the Federal Rules should be construed in conformity

with earlier decisions of this Court declaring the effect to be given, under the general law, to findings of fact by District Courts. In that case the decision of the Court below in the instant case is probably in conflict with the decisions of this Court in *Davis v. Schwartz,* 155 U. S. 631, 636, and *Adamson v. Gilliland,* 242 U. S. 350, 351, holding that "so far as there is any testimony consistent with the finding, it must be treated as unassailable", and with the decision of this Court in *Butte & Superior Co. v. Clark-Montana Co.,* 249 U. S. 12, 30, wherein this Court held:

> "That if the testimony does not show that it (the conclusion of the court) is correct, it fails to show that it is wrong, and under those circumstances we are not justified in disturbing that conclusion. It is our duty to accept a finding of fact, unless clearly and manifestly wrong."

But in either event, the construction placed by the Court below upon the foregoing italicized provision of the rule is in conflict with the decisions of other Circuit Courts of Appeals which, by recognizing the mandatory effect of findings made by a District Court under Rule 52 (a), have placed a different construction thereon from that adopted by the Court below. *Strong-Scott Mfg. Co. v. Weller,* 112 F. (2d) 389, 393 (CCA-8) and *Crowell v. Baker Oil Tools,* 99 F. (2d) 574, 577 (CCA-9).

As the Circuit Court of Appeals did not adjudge the findings of fact of the District Court clearly erroneous, the decree of the District Court still stands, as a matter of law, supported and made mandatory by those findings.

It is therefore believed that this Court should, in the interest of clarification and uniformity of action by the lower Federal Courts, now authoritatively define and de-

clare the true meaning, purpose and effect of Rule 52 (a) in accordance with the object and intention sought to be accomplished by this Court in the promulgation of that Rule.

Point II. In Reading Into an Alleged Prior Art Patent and Publication Certain Modifications Not Disclosed Therein, the Only Basis for Which Is Found in the Disclosures and Teachings of the Patents in Suit and Nowhere in the Prior Art, the Court Below Has Decided a Federal Question in a Way Probably in Conflict With an Applicable Decision of This Court.

The foregoing analysis of the opinion of the Court below demonstrates that the decision of the Court below holding the patents in suit anticipated by the Kops Patent No. 1,833,325 and the Princette publication is based not upon the actual disclosures of that patent and publication, but upon the modification and reconstruction thereof made by the Court below in the light of the teachings of the patents here in issue.

Such arbitrary and unwarranted action by the Court below which is thus disclosed as the sole basis for its decision, brings the decision of the Court below into conflict with the applicable and controlling principle of law as enunciated by this Court in the case of *Topliff v. Topliff and Another,* 145 U. S. 156, 161, wherein this Court said:

> "While it is possible that the Stringfellow and Surles patent might, by a slight modification, be made to perform the function of equalizing the springs which it was the object of the Augur patent to secure, that was evidently not in the mind of the patentees, and the patent is inoperative for that purpose. Their device evidently approached very near the idea of an equalizer;

but this idea did not apparently dawn upon them, nor was there anything in their patent which would have suggested it to a mechanic of ordinary intelligence, unless he were examining it for that purpose. It is not sufficient to constitute an anticipation that the device relied upon might, by modification, be made to accomplish the function performed by the patent in question, if it were not designed by its maker, nor adapted, nor actually used, for the performance of such functions."

Point III. In Reading Into an Alleged Prior Art Patent and Publication Modifications Whose Only Basis Is Found in the Inventions of the Patents in Suit and Nowhere in the Prior Art, and in Thereupon Using Such Modified Prior Art References to Invalidate the Patents in Suit, the Court Below Has Rendered a Decision in Conflict With Decisions of Other Federal Courts Upon the Same Important Question of Federal Law.

This action by the Court below which renders the decision of the Court below probably in conflict with an applicable decision of this Court, likewise and at the same time brings it into conflict with the following decisions, among others, of the Circuit Courts of Appeals of other Circuits, upon the same important question of federal law:

John W. Gottschalk Mfg. Co. v. Springfield Wire & T. Co., 74 F. (2d) 583, 586 (CCA-1);
Firestone Tire & Rubber Co. v. United States Rubber Co., 79 F. (2d) 948, 959 (CCA-6);
Williams Iron Works Co. v. Hughes Tool Co., 109 F. (2d) 500, 506 (CCA-10).

The principle or theory underlying the decisions of the Courts in these cases is forcibly stated in the case of

Western Electric Co. v. Home Tel. Co., 85 Fed. 649, 655-6 (S. D. Ala.) thus:

> "The Supreme Court, in Topliff v. Topliff, 145 U. S. 156, at page 161, 12 Sup. Ct. 828, has said:
>
> " 'It is not sufficient, to constitute an anticipation, that the device relied upon might, by modification, be made to accomplish the function performed by the patent in question, if it were not designed by its maker, nor adapted, nor actually used, for the performance of such functions.'
>
> "The force of this ruling, and the similar ruling in Clough v. Barker, 106 U. S. 175, 1 Sup. Ct. 188, is made manifest, in its practical application to the rights of parties, by the reflection that all earlier patents set up in defense against a later patent sued upon are but the record evidence of the status the art has reached. The rights under such later patent are subject to what this record evidence actually shows. *To change this record, by permitting theoretical modifications of these earlier patents, would be the same, in principle, as to change, by interpolation or modification, any other evidence between the parties.*"

The conflict between the decision of the Court of Appeals in this case and decisions of other Circuit Courts of Appeals upon the same important federal question, thus resulting from the action of the Court below, should, it is believed, in the interests of the proper and uniform administration of the patent law, be considered and resolved by this Court.

CONCLUSION.

WHEREFORE, petitioner prays that the decision of the Court below be reviewed and reversed by this Honorable Court, and to that end that the writ of certiorari herein prayed for be granted.

Respectfully submitted,

HUGH M. MORRIS,
FREDERIC BURNHAM,
DONALD MALCOLM.

December 20, 1940.